

## **REMARKS/AGRGUMENTS**

The Examiner has rejected the Applicants' claims 1, 4-12, 19-25, 27-38, 40, 42-50, and 52-57 on various grounds. The Examiner's rejections are addressed below in the order in which they appear in the office action.

### **Species Claims**

The Examiner has apprised the Applicants that claims 2, 3, 13-18, 26, 39, 41, 51, and 58 are withdrawn as being drawn to non-elected species. The Applicants submit that the withdrawn claims are fully embraced, respectively, by generic claims 1, 12, 23, 37, 40, 48, and 55. As discussed below, the Applicants submit that each of the generic claims is allowable, as amended, and that the number of species claims is not unreasonable. Accordingly, the Applicants respectfully request that the examiner reinsert and allow the withdrawn species claims as instructed by MPEP 809.02(c)(B)(1).

### **Claim Rejections under 35 U.S.C. §112**

The Examiner has rejected claims 20 and 21, noting that he was "unable to find the bottom with a expansion mechanisms for expanding the shoe longitudinally and including the slots as claimed." Notwithstanding this rejection, the Applicants point to Figure 27B of the specification, depicting elastic membranes on the bottom of the shoe that allow the bottom to expand away from an inlay in both the lateral and longitudinal directions. See also related description at page 36, lines 14 – 25, and page 37, lines 3-8. The Applicants believe that the claim language is clear, and that it is supported by the written description. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection of claims 20 and 21 under 35 U.S.C. §112.

### **Claim Rejections under 35 U.S.C. §102**

The Examiner has rejected claims 1, 4-10, 12, 23, 24, 25, 27, 37, 38, 40 ,42-46, 48, 49, 50, and 52-57 as being anticipated in view of US 6,519,876 to Geer at al. ("Geer").

Independent claims 1, 12, 40, 48, and 52-55 are directed to a shoe including an expansion mechanism, and methods of forming and expanding footwear having such an expansion

mechanism. The Applicants' expansion mechanism responds to a downward force applied to the shoe, such as when loaded during a step, to create an outward, or lateral force that expands the shoe in anticipation of the accompanying expansion of a foot, or assists in the expansion of the shoe otherwise caused by the expanding foot. The claims have been amended to clarify this inventive concept. These amendments are supported by the specification, for example at page 2, lines 10 – 27, page 3 lines 18-23, and Figure 6B. No new matter has been added.

In contrast to the presently claimed expansion mechanism, Geer teaches a passive expansion joint that can yield to accommodate an expanding foot (see Geer, col. 31, ll. 12 et seq.), but does not in any way redirect the downward force of the foot to assist in this process. The Geer reference does not teach or suggest an expansion mechanism that is adapted to expand in response to a downward force, as presently claimed. Geer cannot anticipate these claims, nor can Geer be combined with the other art cited by the examiner to render these claims obvious. The Applicant respectfully requests that the examiner withdraw this rejection based upon Geer.

Claims 23 and 37 are directed to a shoe comprising, inter alia, a chassis having at least three tailored zones, at least two of which are joined by a transition zone comprising material from each adjacent one of the tailored zones. The transition zones are depicted, for example, in Figures 15E and 15F, and more fully described on page 29, line 14 et seq. As shown, the transition zones may be created by beveling the materials of two adjacent zones so that the material transitions from one type to another smoothly and continuously while maintaining uniform thickness of the chassis. The claims have been amended to more particularly recite this feature. These amendments are supported by the specification and no new matter has been added.

In contrast to the applicant's claimed shoe, the shoes disclosed in Geer do not employ any transition zones, nor does Geer suggest transitioning any materials in this manner. While Geer may mention use of different materials in different portions of the insole, Geer does not teach or suggest any transitions between adjacent zones. Since Geer does not teach or suggest the presently claimed transition zones, Geer cannot anticipate these claims or render them obvious. The Applicant respectfully requests that the examiner withdraw this rejection based upon Geer.

Finally, the Examiner has rejected claim 47 under 35 U.S.C. §102(b) as being anticipated by US 4,599,810 (Sacre). The Applicants' liner *stretches* by yielding along and within the surface of the liner material. This liner need not move or shift relative to the upper. See page 23, lines 5-6. The Sacre patent does not describe a liner that stretches in the manner claimed. Instead, Sacre shows a liner material that *unfolds* to permit insertion and removal of the foot. The Applicants have not identified any other regions in the Sacre patent that suggest the stretchable liner claimed by the Applicants. Since Sacre does not teach a liner that *stretches* as that term is used in the claims, Sacre does not teach all of the limitations of amended claim 47 and therefore cannot anticipate the claim. No new matter has been added by the amendment to claim 47, and the amendment is supported by the specification. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection to claim 47 based on Sacre.

Claim Rejections under 35 U.S.C. §103(a)

The Examiner has rejected claims 33-36 as being unpatentable over Geer in view of Donnadieu, which teaches a liner for a ski or skating boot. The Applicants respectfully traverses this rejection. Claim 33 recites a shoe comprising, inter alia, a waterproof, breathable liner having an expandable region in the metatarsal and toe zones and non-expandable region in the heel zone. Neither the Donnadieu reference nor the Geer patent teaches or suggests a waterproof, breathable liner with the claimed expandable and non-expandable regions. Accordingly, these references cannot render the Applicants' claims obvious – either alone or in combination.

See  
rejection

The Applicants also note that Donnadieu is directed to a ski boot or a skating boot, and the Examiner has not established that the construction of such boots has general applicability in the construction of ordinary shoes, such that the Donnadieu should be considered as analogous prior art. Donnadieu is not in the field of Applicant's endeavor nor is it reasonably pertinent to the particular problems with which the present application is concerned. Donnadieu is directed to a sports boot, particularly to the problem of improving foot positioning, balance, stability, and support during the performance of sports. (See Col 2, lns 5 - 38). The Applicants' objective is to achieve greater comfort and lessen the pressure on the foot. The Donnadieu invention and the Applicants' invention are simply directed to different problems. In view of the foregoing, the

Applicants respectfully request that the Examiner withdraw all obviousness rejections to independent claim 33.

### **CONCLUSION**

In view of the foregoing, all of the pending, independent claims are believed to be in condition for allowance. For similar reasons, all of the claims depending therefrom are also believed to be in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000.

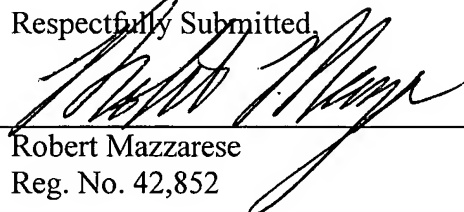
**The Applicants request a phone interview with the Examiner concerning this application.**

A request for a one-month extension of time accompanies this response in a separate paper. Should an additional extension of time be required or any other fees required in connection with this paper, the Applicants hereby petition for the same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

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Respectfully Submitted,

  
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